

09-07-06

PTO/SB/21 (09-04)

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<input type="checkbox"/> Express Abandonment Request	<input type="checkbox"/> Request for Refund	Copy of date stamped postcard filed August 6, 2004; Copies of Declaration of Eric J. Ruff with Exhibit A, B and C filed August 6, 2004
<input type="checkbox"/> Information Disclosure Statement	<input type="checkbox"/> CD, Number of CD(s) _____	
<input type="checkbox"/> Certified Copy of Priority Document(s)	<input type="checkbox"/> Landscape Table on CD	
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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm	TraskBritt, P.C.		
Signature			
Printed Name	Brick G. Power		
Date	September 5, 2006	Reg. No.	38,581

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:

Hixon et al.

Serial No.: 10/718,852

Filed: November 20, 2003

For: DIE CUTTING SYSTEM,
COMPONENTS THEREOF, AND
METHODS

Confirmation No.: 1905

Examiner: S. Choi

Group Art Unit: 3724

Attorney Docket No.: 2916-4842.1US

NOTICE OF EXPRESS MAILING

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APPEAL BRIEF

Mail Stop Appeal Brief – Patents
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Attn: Board of Patent Appeals and Interferences

Sir:

This APPEAL BRIEF is being submitted in the format required by 37 C.F.R.

§ 41.37(c)(1). The accompanying fee has already been paid.

(1) **REAL PARTY IN INTEREST**

U.S. Application Serial No. 10/718,852 (hereinafter “the ‘852 Application”), the application at issue in the above-referenced appeal, has been assigned to QuicKutz, Inc., as evidenced by the assignment that has been recorded with the U.S. Patent & Trademark Office (hereinafter “the Office”) at Reel No. 013271, Frame No. 0566. Accordingly, QuicKutz, Inc. is the real party in interest in the above-referenced appeal.

(2) **RELATED APPEALS AND INTERFERENCES**

The final rejections of the claims in U.S. Application Serial No. 09/864,723, filed on May 23, 2001, are currently the subject of an appeal to the Board of Patent Appeals and Interferences (hereinafter “the Board”). The Board’s review of that application may have some bearing on the Board’s decision in the above-referenced appeal.

(3) **STATUS OF CLAIMS**

There are currently seventy-seven (77) claims pending and under consideration in the above-referenced application.

Of these, the Examiner has withdrawn claims 1-47 and 49-60 from consideration, and has considered and finally rejected claims 48 and 61-77. The Examiner’s refusal to consider claims 1-47 and 49-60 and the final rejections of claims 48 and 61-77 are subject to this appeal.

No claims have been allowed.

(4) STATUS OF AMENDMENTS

The '852 Application was filed on November 20, 2003, with thirty-five (35) claims.

A Preliminary Amendment was mailed on July 22, 2003.

On February 26, 2004, a Petition to Make Special was filed in view of an ever-increasing number of subsequently introduced copy-cat products that would infringe the scopes of the pending claims of the '852 Application.

A first action on the merits of claims 1-35 was mailed on May 24, 2004. In that action, each of the pending claims was rejected. An Examiner's Interview was conducted on June 15, 2004, in which differences between Appellants' chemically etched die and the art were discussed, as were several features that could be included in the claims to distinguish the same over the prior art.

Following the Examiner's Interview, several revisions to the previously pending claims were presented, as were new claims 36-77—each addressing differences between the art upon which the Examiner had based his claim rejections and Appellants' chemically etched die. That Amendment was accompanied by a Declaration of Eric J. Ruff, the President and C.E.O. of QuicKutz, Inc., which detailed the commercial success of and long-felt need for the claimed apparatus. The Amendment and Declaration were sent to the Office on August 2, 2004.

That Amendment was followed by a 14-way restriction requirement, in which the Examiner admitted commonalities between seven of the groups by indicating that claim 48 would be considered if any of those seven groups was elected.

An election was made, in a Response dated March 2, 2005, to prosecute claims 61-77 of Group 14.

Although Group 14 was not one of the seven identified groups with which claim 48 would also be considered, the Examiner rejected claims 48 and 61-77 in a final Office Action dated December 2, 2004.

A Notice of Appeal was filed on January 17, 2006, and an APPEAL BRIEF was subsequently filed. A Notice of Non-Compliant Appeal Brief was sent on August 3, 2006, and is followed by this APPEAL BRIEF. As September 3, 2006, fell on a Sunday, the following Monday, September 4, 2006, was the federal Labor Day holiday, and this APPEAL BRIEF is being submitted on Tuesday, September 5, 2006, it should be deemed to have been filed within one month of the mailing date of the Notice of Non-Compliant Appeal Brief.

(5) SUMMARY OF CLAIMED SUBJECT MATTER

The '852 Application includes claims that are directed to dies for forming patterns in sheets of material. Such a die includes a plate and at least one cutting edge protruding from a surface of the plate. *See, e.g.,* paragraph [0030]; independent claims 48 and 62.

The plate may be portable and configured for use with a portable press. *See, e.g.,* paragraph [0016]; claims 62-68 and 70-77. The plate of the die may be substantially planar. *See, e.g.,* paragraph [0030]; claims 48, 61-68, and 70-77. It may have a peripheral edge with a dimension of, at most, about two inches. Paragraph [0037]; claims 71-74.

The plate of the die may be substantially rigid. *See, e.g.,* paragraph [0035]; claims 48 and 61. The thickness or rigidity of the plate may be sufficient to maintain planarity when the die is unsupported. Claims 62-68 and 70-77. The plate may also be configured to apply pressure

simultaneously to at least one cutting edge of the die. *See, e.g.*, paragraph [0041]; claims 61 and 77.

(6) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

- (A) The rejection of claims 64-68 and 70 under 35 U.S.C. § 112, second paragraph, for various informalities;
- (B) The rejection of claims 48, 61, 62, 68, 75, and 77 under 35 U.S.C. § 102(b) for being drawn to subject matter that is allegedly anticipated by the subject matter described in U.S. Patent 3,469,488 to Gaspari (hereinafter “Gaspari”);
- (C) The rejection of claims 48, 61-67, and 77 under 35 U.S.C. § 102(b) for reciting subject matter that is purportedly anticipated by the disclosure of U.S. Patent 5,172,622 to Sabin (hereinafter “Sabin”);
- (D) The rejection of claims 48, 61, 62, 68-70, 75, and 76 under 35 U.S.C. § 102(b) for being directed to subject matter that is assertedly anticipated by the subject matter described in U.S. Patent 4,537,588 to Ehlscheid et al. (hereinafter “Ehlscheid”); and
- (E) The 35 U.S.C. § 103(a) rejection of claims 71-74 for reciting subject matter that is allegedly unpatentable over teachings from either Gaspari or Ehlscheid.

(7) ARGUMENT

A. REJECTIONS UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

Claims 64-68 and 70 have been rejected under 35 U.S.C. § 112, second paragraph, for various informalities.

It is clear from the language of claim 64 that the support recited therein is not necessarily the same as the substantially rigid support recited in claim 63. Therefore, claim 64 complies with the definiteness requirement of the second paragraph of 35 U.S.C. § 112.

With respect to claims 65 and 70, it is noted that there are typographical errors and antecedent basis issues in these claims that may be addressed in the future. In any event, independent claim 62 from which claims 65 and 70 depend, should recite that the edge protrudes from the front side of the substantially planar plate, rather than from the front side of a “substantially planar die supporting surface,” while it is evident that “said surface” referred to in claims 65 and 70 is the “front side” of independent claim 62.

It is likewise evident that the recitation of “said surface” in claim 68 is the “front side” of independent claim 62. Additionally, it is noted that “said distance” should be replaced with “a distance” when the ‘852 Application reenters prosecution.

B. REJECTIONS UNDER 35 U.S.C. § 102(b)

1. APPLICABLE LAW

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single reference which qualifies as prior art under 35 U.S.C. § 102. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

2. ART RELIED UPON

Gaspari

Gaspari describes, among other things, a thick, molded plastic die 10 including a base 11 with integral cutting ridges 14, 14a protruding from the surface thereof. FIGs. 1 and 2; col. 3, line 71, to col. 4, line 22. Overall, the thickness of the die 10 is a quarter of an inch, with the base 11 making up the majority (over two-thirds) of that thickness. Col. 4, lines 12-22. This thick base 11 is required so that the force applied against the back side of the die is uniformly distributed over the entire cutting surface of the die. Col. 4, lines 29-31. Although Gaspari notes that the thickness of the die may be irrelevant, that is only the case where at least the cutting edge of the die is “attached to a harder, more rigid support backing.” Col. 4, lines 23-29.

Sabin

The die element 12 of the table-top die cutting apparatus 10 described in Sabin includes a body 30 with “at least two flat, upstanding sides . . .” Col. 3, lines 40-45. A cutting edge 32 protrudes from the body 30. Col. 3, lines 45-46.

Ehlscheid

Ehlscheid describes a die which is configured to be used on a rotary press. The die of Ehlscheid has a curvature which facilitates securing of the die to a partially cylindrical drum. The drum is part of a rotary press, which, as is well known in the art, is a heavy piece of industrial equipment, typically weighing several hundred pounds. In addition to being curved, the die of Ehlscheid includes opposite edges that are bent toward one another. FIG. 2; col. 3,

lines 38-41. These inwardly bent edges are configured to be engaged by corresponding features of the drum and, thus, facilitate securing of the die to the drum. Col. 3, lines 39-44. The curvature and the bent edges of the die guarantee that the die is accurately clamped to the drum and that the holes in the die register with corresponding holes in the drum. Col. 3, lines 38-44. In addition to the bent edges, screws and clamps secure the die of Ehlscheid to a drum. *Id.*; col. 4, lines 13-21.

Holes are formed within the confines of the cutting edges of the die described in Ehlscheid so that a vacuum may be applied to paper to hold the same in place relative to the die and a drum by which the die is carried during cutting. Col. 4, lines 22-30. Such holes are necessary because it is not desirable for a cutout to be immediately ejected from the die once a sheet of material has been cut. The holes in the die also facilitate the application of a positive pressure to a cutout piece of paper to remove the same from the die at a desired point in time following cutting. Col. 4, lines 27-30.

The die described in Ehlscheid has a total thickness of 0.5 mm, which is equal to 20 mils, or 0.02 inch. Col. 3, lines 19-21. The heights of the cutting edges of the die are 0.3 mm, which is equal to 12 mils, or 0.012 inch. Col. 3, lines 30-32. The backing of the die disclosed in Ehlscheid has a thickness of 0.2 mm, which is equal to 8 mils or 0.008 inch. Col. 3, lines 25-27.

3. ANALYSIS

Claims 48, 61-70, and 75-77 stand finally rejected under 35 U.S.C. § 102(b).

a. GASPARI

Claims 48, 61, 62, 68, 75, and 77 stand finally rejected under 35 U.S.C. § 102(b) for being drawn to subject matter that is allegedly anticipated by the subject matter described in Gaspari.

Independent claim 48 is directed to a die for forming patterns in a sheet of material. The die of independent claim 48 includes a portable, substantially rigid, substantially planar plate, as well as at least one cutting edge protruding from a surface of the substantially planar plate.

While the die 10 of Gaspari includes a thick base 11 or a support backing to provide it with sufficient rigidity (col. 4, lines 23-31), it is evident that, due to formation of the die 10 from plastic, the base 11 must be sufficiently thick to provide the desired amount of rigidity (*i.e.*, sufficient rigidity that the “force applied against [the die] is uniformly distributed over the entire cutting surface of the die.” Col. 4, lines 29-31).

Further, the only die thickness disclosed in Gaspari is a quarter of an inch, which, in view of the relatively small lateral dimensions and rigidity of the disclosed die, could hardly be considered to be “substantially planar.”

Therefore, it is respectfully submitted that Gaspari lacks any express or inherent description of a die that includes a “substantially planar” plate, as would be required for the disclosure of Gaspari to anticipate each and every element of independent claim 48 under 35 U.S.C. § 102(b).

Claim 61 is allowable, among other reasons, for depending from claim 48, which is allowable.

With respect to the die recited in independent claim 62, it is again noted that Gaspari does not expressly or inherently describe a die with a “substantially planar” plate.

Moreover, Gaspari does not expressly or inherently describe that the die 10 thereof includes “a back side configured to be supported by a substantially planar die supporting surface of a press . . .” (emphasis supplied). Nothing about the apparatus illustrated in FIG. 5 of Gaspari appears to be portable.

In view of the foregoing, it is respectfully submitted that Gaspari does not anticipate each and every element of independent claim 62, as would be required to affirm the 35 U.S.C. § 102(b) rejection of that claim.

Claims 68, 75, and 77 are each allowable, among other reasons, for depending from claim 62, which is allowable.

Claim 68 is additionally allowable since Gaspari neither expressly nor inherently describes that the cutting ridges 14, 14a of the die 10 disclosed therein protrude from a surface of the base 11 of that die 10 a distance that is greater than the thickness of the base 11. Instead, the disclosure of Gaspari is limited to a die 10 with a base 11 that has a thickness of 0.17 inch and cutting ridges 14, 14a that protrude a much shorter distance, 0.08 inch, from the base 11.

b. SABIN

Claims 48, 61-67, and 77 have been finally rejected under 35 U.S.C. § 102(b) for reciting subject matter that is purportedly anticipated by the disclosure of Sabin.

The die 12 described in Sabin includes a body 30 with “at least two flat, upstanding sides . . .” *See, e.g.*, col. 3, lines 40-54. As the sides of the body 30 of the die 12 are upstanding,

it is evident that the die itself could not include a “substantially planar” plate, as would be required for the disclosure of Sabin to anticipate each and every element of independent claims 48 and 62.

Furthermore, Sabin does not expressly or inherently describe that the press disclosed therein is portable or, thus, that the dies that may be used with that press include back sides that are configured to be supported by a corresponding surface of a portable press, as required by independent claim 62.

Therefore, the disclosure of Sabin does not anticipate each and every element of either independent claim 48 or independent claim 62.

Claim 61 is allowable, among other reasons, for depending from claim 48, which is allowable.

Each of claims 63-67 and 77 is allowable, among other reasons, for depending from claim 62, which is allowable.

c. EHLSCHEID

Claims 48, 61, 62, 68-70, 75, and 76 are finally rejected under 35 U.S.C. § 102(b) for being directed to subject matter that is assertedly anticipated by the subject matter described in Ehlscheid.

Notably, dies that are configured for use in rotary presses, such as that disclosed in Ehlscheid, have thin, chemically etched configurations that are not configured to be used by individual consumers. Because the backings of such dies are flexible and, thus, relatively thin (e.g., the backing of the Ehlscheid die is only 0.2 mm, or 8 mils thick), the edges of the backings

of such dies are razor sharp. Consequently, such dies tend to cut even the fingers of industrial handlers who have been trained to secure such dies to and remove them from rotary presses.

As the disclosure of Ehlscheid is limited to flexible dies for use with rotary presses, Ehlscheid lacks any express or inherent description of a die that includes a substantially rigid.

Moreover, the die of Ehlscheid does not include a substantially planar plate. Rather, the plate of that die has a curvature and is bent to include two inwardly extending edges. FIG. 2; col. 3, lines 38-41.

Thus, Ehlscheid does not anticipate each and every element of independent claim 48, as would be required to affirm the 35 U.S.C. § 102(b) rejection of that claim.

Claim 61 is allowable, among other reasons, for depending from claim 48, which is allowable. Claim 61 is additionally allowable because, in view of Ehlscheid's limited disclosure that the die thereof is configured for use with an industrial rotary press, it is apparent that all regions of the backside of that die are not concurrently and completely supported "by a substantially planar surface as pressure is simultaneously applied to all of [the] cutting edge" of that die. Instead, Ehlscheid merely discloses that the die is configured to be supported by a curved surface, and that pressure is only applied linearly across the die and, thus, to only portions of a cutting edge at any point in time.

With respect to the subject matter recited in independent claim 62, it is respectfully submitted that the disclosure of Ehlscheid is limited to dies that are configured for use with industrial rotary presses, not for use with portable pressures. Thus, Ehlscheid includes no

express or inherent description of a die that includes a back side configured to be supported by a substantially planar die supporting surface of a portable press. Further, since the die of Ehlscheid is flexible, it does not include a plate with “a thickness [to] maintain its substantial planarity when not supported . . .” Therefore, under 35 U.S.C. § 102(b), the disclosure of Ehlscheid does not anticipate each and every element of independent claim 62.

Each of claims 68-70, 75, and 76 is allowable, among other reasons, for depending from claim 62, which is allowable.

Claim 75 is additionally allowable since Ehlscheid does not expressly or inherently describe that the die thereof has dimensions that facilitate compact and portable storage thereof. Again, the die of Ehlscheid is relatively large and configured for industrial use.

Reversal of the 35 U.S.C. § 102(b) rejections of claims 48, 61-70, and 75-77 is respectfully requested, as is the allowance of each of these claims.

C. REJECTIONS UNDER 35 U.S.C. § 103(a)

1. APPLICABLE LAW

The standard for affirming a rejection under 35 U.S.C. § 103(a) is set forth in M.P.E.P. § 706.02(j), which provides:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim

limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Secondary considerations of nonobviousness include "commercial success, long felt but unsolved needs, failure of others, etc." M.P.E.P. § 2141, quoting *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966).

2. ANALYSIS

Claims 71-74 stand finally rejected under 35 U.S.C. § 103(a) for being directed to subject matter that is allegedly unpatentable over teachings from either Gaspari or Ehlscheid.

Each of claims 71-74 is allowable, among other reasons, for depending from claim 62, which is allowable.

Moreover, it is respectfully submitted that there are at least two reasons that a *prima facie* case of obviousness has not been established against any of claims 71-74.

First, it is respectfully submitted that neither Gaspari nor Ehlscheid teaches or suggests the dimensions recited in any of these claims.

Second, in view of the fact that Gaspari and Ehlscheid both lack any teaching or suggestion that the dies thereof may be used with portable presses, it is respectfully submitted that one of ordinary skill in the art wouldn't have been motivated to develop dies with the dimensions recited in any of claims 71-74.

Furthermore, the Declaration of Eric J. Ruff that was filed in the '852 Application on August 2, 2004, identifies several reasons that dies having the dimensions recited in each of

claims 71-74 would have been non-obvious as of the date to which a claim for priority has been made in the above-referenced application.

It is respectfully requested that the 35 U.S.C. § 103(a) rejections of claims 71-74 be withdrawn and that each of these claims be allowed.

(8) CLAIMS APPENDIX

A listing of claims 48 and 61-77 is attached as the CLAIMS APPENDIX to this APPEAL BRIEF.

(9) EVIDENCE APPENDIX

A copy of the Declaration of Eric J. Ruff, which was filed in the '852 Application on August 2, 2004, is enclosed as an EVIDENCE APPENDIX to this APPEAL BRIEF.

(10) RELATED PROCEEDINGS APPENDIX

There is no RELATED PROCEEDINGS APPENDIX to this APPEAL BRIEF.

(11) CONCLUSION

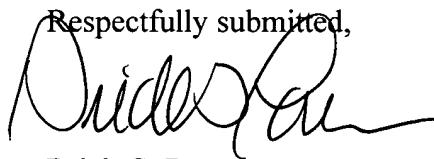
It is respectfully submitted that:

(A) The rejections of claims 64-68 and 70 under 35 U.S.C. § 112, second paragraph, for various informalities will be addressed at a later date;

- (B) Claims 48, 61, 62, 68, 75, and 77 are allowable under 35 U.S.C. § 102(b) for being drawn to subject matter that is not anticipated by the subject matter described in Gaspari;
- (C) Claims 48, 61-67, and 77 are allowable under 35 U.S.C. § 102(b) for reciting subject matter that is patentable over the subject matter disclosed in Sabin;
- (D) Claims 48, 61, 62, 68-70, 75, and 76 recite subject matter that, under 35 U.S.C. § 102(b), is allowable over the subject matter described in Ehlscheid; and
- (E) Claims 71-74 are each allowable under 35 U.S.C. § 103(a) for being drawn to subject matter that is patentable over the teachings of both Gaspari and Ehlscheid.

Accordingly, reversal of the rejections of claims 48, 61-68, and 70-77 is respectfully solicited, as is the allowance of each of these claims.

Respectfully submitted,



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Date: September 5, 2006
BGP/eg
Document in ProLaw

CLAIMS APPENDIX

48. A die for forming patterns from a sheet of material, comprising:
a portable, substantially rigid, substantially planar plate;
at least one cutting edge protruding from a surface of said substantially planar plate.
61. The die of claim 48, wherein all regions of a back side of said portable, substantially rigid, substantially planar plate located opposite said at least one cutting edge are configured to be concurrently and completely supported by a substantially planar surface of a portable die cutting apparatus as pressure is simultaneously applied to all of said at least one cutting edge.
62. A die for forming patterns from a sheet of material, comprising:
a substantially planar plate including a back side configured to be supported by a substantially planar die supporting surface of a portable press and having a thickness maintain its substantial planarity when not supported by said substantially planar die supporting apparatus; and
a cutting edge protruding from a front side of said substantially planar die supporting surface, said cutting edge being configured cut through the sheet of material as pressure is applied to said back side of said substantially planar plate.
63. The die of claim 62, wherein said cutting edge is configured to cut through the sheet of material as said cutting edge is forced against a substantially rigid support.

64. The die of claim 63, wherein said cutting edge is configured to cut through the sheet of material as said cutting edge is forced against a support formed from a material that is softer than the material from which the cutting edge is formed.

65. The die of claim 62, further comprising:

at least one ejection element associated with said surface of said substantially planar plate, said at least one ejection element being configured to immediately force a sheet of material from a location laterally adjacent to the at least one cutting edge upon removal or pressure from the die.

66. The die of claim 65, wherein said at least one ejection element comprises at least one compressible, resilient member.

67. The die of claim 65, wherein at least a portion of said at least one ejection element is positioned within a periphery defined by said at least one cutting edge.

68. The die of claim 62, wherein said distance said at least one cutting edge protrudes from said surface of said substantially planar plate is greater than a thickness of said substantially planar plate.

70. The die of claim 62, wherein said at least one cutting edge protrudes from said surface of said substantially planar plate a distance of about 0.015 inch to about 0.02 inch.

71. The die of claim 62, wherein at least one peripheral dimension of said substantially planar plate is at most about 2 inches.

72. The die of claim 71, wherein said substantially planar plate is rectangular in shape and has peripheral dimensions of at most about 2 inches by about 2 inches.

73. The die of claim 62, wherein at least one peripheral dimension of said substantially planar plate is about 2 inches.

74. The die of claim 73, wherein said substantially planar plate has peripheral dimensions of about 2 inches by about 2 inches.

75. The die of claim 62, wherein said substantially planar plate has dimensions which facilitate compact and portable storage thereof with a plurality of other similarly dimensioned dies.

76. The die of claim 62, wherein said substantially planar plate comprises at least one of a magnetic material and a material which is attractable to a magnetic field.

77. The die of claim 62, wherein all regions of a back side of said portable, substantially rigid, substantially planar plate located opposite said at least one cutting edge are configured to be concurrently and completely supported by a substantially planar surface of a portable die cutting apparatus.

EVIDENCE APPENDIX

THE PATENT & TRADEMARK OFFICE MAILROOM DATE
STATED HEREON IS AN ACKNOWLEDGEMENT THAT ON THIS
DATE THE PATENT & TRADEMARK OFFICE RECEIVED:

Transmittal Form (in duplicate); Fee Transmittal Form (1 page); Check No. 6437 in the amount of \$464.00 for additional claims; Amendment in response to Office Action dated May 24, 2004 (22 pages); and Declaration of Eric J. Ruff (4 pages) Exhibit A (4 pages) Exhibit B (4 pages) Exhibit C (2 pages).

Invention: DIE CUTTING SYSTEM, COMPONENTS THEREOF AND METHODS

Applicant(s): Hixon et al.

Filing Date: November 20, 2003

Serial No.: 10/718,852

Date Sent: August 2, 2004 via first class mail

Docket No.: 2916-4842.1US

BGP/rmh





PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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For: DIE CUTTING SYSTEM,
COMPONENTS THEREOF, AND
METHODS

Confirmation No.: 1905

Examiner: S. Choi

Group Art Unit: 3724

Attorney Docket No.: 2916-4842.1US

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DECLARATION OF ERIC J. RUFF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

I, Eric J. Ruff, declare that:

1. I am over twenty-one years of age and competent to give sworn testimony.
2. I am the President and C.E.O. of QuicKutz, Inc., (hereinafter "QuicKutz") a corporation organized under the laws of the State of Utah. I have served in that capacity at QuicKutz since its organization on September 5, 2001.

3. U.S. Patent Application Serial No. 10/718,852 (hereinafter the '852 Application) has been assigned to QuicKutz, the assignment having been recorded with the U.S. Patent & Trademark Office at Reel No. 013271, Frame No. 0566.

Commercial Success

4. In 2002, QuicKutz released to the U.S. market a portable personal die cutting system using substantially rigid chemically etched dies of the type recited in the claims of the '852 Application.
5. In 2002, QuicKutz's first full year of operation, approximately \$236,000 was expended on advertising, which included advertising for its chemically etched dies. The advertising included printed advertisements in scrapbooking publications, a printed catalog that was made available in retail stores that sold QuicKutz products, development of a website, updates and maintenance to the website, and expenses associated with trade shows. Extensive of word-of-mouth advertising, at no cost to QuicKutz, also occurred during 2002.
6. Between May 1, 2002, and December 31, 2002, QuicKutz sold approximately 439,000 dies of the type recited in the claims of the '852 Application. This sales volume amounted to approximately \$1,917,000 in gross revenues for QuicKutz during 2002, not including die cutting tools that were sold for use with the dies. (In 2002, most of QuicKutz's die cutting tools were sold in kits that included a set of dies, and the \$1,917,000 figure involves an allocation of the purchase price of such kits between the tool and the dies.)
7. Total revenues during 2002 that were attributable to QuicKutz's portable personal die cutting tools and the dies designed for use therewith amounted to approximately \$2,381,000, representing approximately a 10x return on QuicKutz's 2002 investment in advertising.
8. QuicKutz spent approximately \$199,000 on advertising in 2003. Again, such advertising included expenses relating to trade shows, updates to and maintenance of QuicKutz's website, catalogs, and printed advertisements in scrapbooking magazines. Again, extensive of word-of-mouth advertising, at no cost to QuicKutz, occurred during 2003.
9. In 2003, QuicKutz sold approximately 2,127,000 dies of the type recited in the claims of the '852 Application, which amounted to gross sales of approximately \$7,449,000, not including die cutting tools that were sold for use with the dies. (Again, many tools were sold in kits, and the \$7,449,000 figure involves an allocation of the purchase price of such kits between the tool and the dies included therein.)

10. Total revenues during 2003 that were attributable to QuicKutz's portable personal die cutting tools and the dies designed for use therewith amounted to approximately \$8,907,000, representing approximately a 45x return on QuicKutz's 2003 investment in advertising.
11. Through June 30, 2004, QuicKutz has spent approximately \$301,000 on advertising, including expenses relating to trade shows, printing costs for new catalogs, costs associated with advertisements in scrapbooking magazines, and continued updates to and QuicKutz's website. Extensive of word-of-mouth advertising, at no cost to QuicKutz, has also occurred during 2004
12. During the first six months of 2004, QuicKutz sold approximately 1,705,000 of its dies of the type recited in the claims of the '852 Application. Its gross sales of dies amounted to approximately \$4,795,000, not including sales from tools that were sold for use with the dies.
13. Total revenues during the first six months of 2004 that were attributable to QuicKutz's portable personal die cutting tools and the dies designed for use therewith amounted to approximately \$5,328,000, representing approximately an 18x return on QuicKutz's 2004 investment in advertising.
14. These numbers show the commercial success of dies that fall within the scope of the claims of the '852 Application. Sales figures including tool sales are considered to be indicative of the commercial success of QuicKutz's rigid chemically etched dies, because all of QuicKutz's advertising has promoted both its dies and the portable personal die cutting system in which they are used.

Long-Felt Need

15. Shortly after QuicKutz introduced its portable personal die cutting system into the market, many customers and commentators observed that the QuicKutz dies uniquely satisfied a need that had not previously been met in the scrapbooking industry. The attached Exhibit A is a sampling of magazine articles to that effect, including (i) an announcement/review printed in the November/December 2002 issue of *Memory Makers* magazine, observing that the QuicKutz dies make possible "more intricate, cleaner design cuts;" (ii) a review printed in the April/May 2003 issue of *PaperKuts* magazine noting the solid demand for die cuts and stating that the QuicKutz dies deliver "the sharp, crisp look of store cut dies" in a personal die cutting system that can be used "in the comfort of your own home"; (iii) an article in the 2003 issue of *Scrapbooking Top 50*, published by Memory Makers, highlighting the portability advantages of the QuicKutz dies by implying that 80 of them weigh about a pound.

16. Shortly after QuicKutz introduced its substantially rigid chemically etched dies into the market, several competitors began offering similar dies as well as die cutting tools that could use such dies.
17. In the fall of 2003, Sizzix, a joint venture between Ellison Educational Equipment, Inc., and Provo Craft and Novelty Inc., began selling an adapter for its portable die cutting tool that permitted the Sizzix tool to use rigid substantially planar dies similar to those described in the '852 Application. The attached Exhibit B is a print-out of one of Sizzix's Internet web pages, advertising the desirability of a portable personal die cutting system that uses rigid substantially planar dies.
18. A month or two later, a company known as DayCo, which has since been acquired by AccuCut Systems, began selling a portable die cutting tool, including an adapter that allows the AccuCut tool to use rigid substantially planar dies similar to those described in the '852 Application. The attached Exhibit C is a print-out of one of AccuCut's Internet web pages, advertising the desirability of a portable personal die cutting system, including the ability to use rigid "wafer-thin" dies.
19. These facts indicate the existence of a long-felt and continuing need in the scrapbooking, hobby, and related industries for a personal die cutting system that uses dies of a type described in the claims of the '852 Application.

I declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true, and further that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Dated this 30th day of July, 2004.

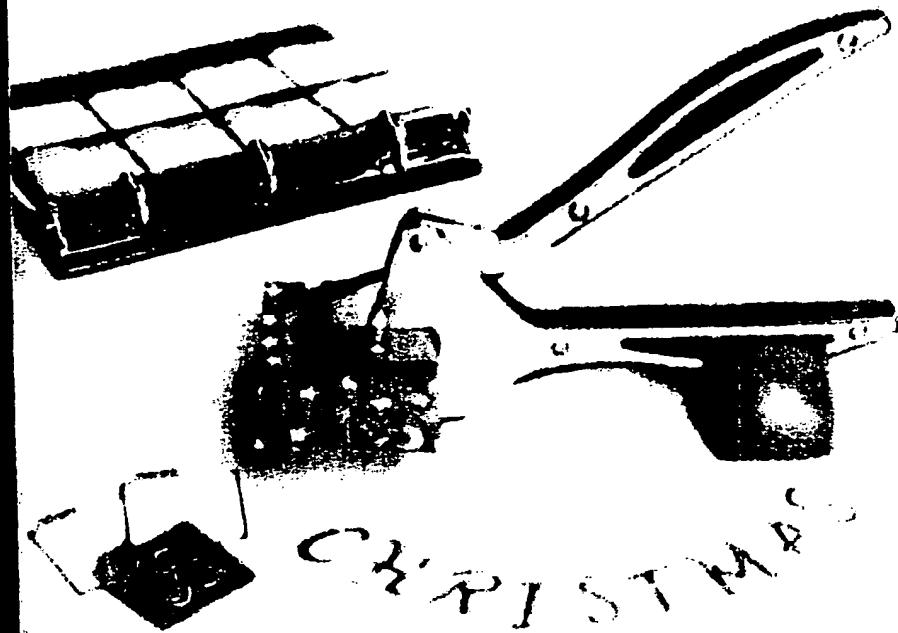


Eric J. Ruff

Exhibit A

Magazine Articles

Scrapbookers | new products



quickutz personal die-cutting system

Here's one for the wish list: the QuickKutz (888-702-1146 • quickutz.com) new personal die-cutting system. This gadget offers portability, ease and speed of use, more alphabet options with shadow letters and more intricate, cleaner design cuts.

In the fall of 2000, Natasha Hixon grew frustrated with the time-consuming task of cutting out letters. After researching some options, she and her husband, Mark, developed a complete die-cutting system that can fit in your purse or crop bag and cut up to 100 shapes in one minute!

Weighing less than two pounds, the basic system, called the Essential Kit, consists of a hand press and cradle in which to rest it, a complete alphabet set, plus two punctuation dies, three shapes and a storage binder. \$200-\$320

stocking stuffer

Does this cut's lil' thing remind you of a scrapbooker you know? She would if she had blond hair, you say? Not a problem, Critter Crafts (949-858-6271 • scrapbookcritter.com) can customize these ornaments with hair color and style, skin tone and even ethnicity.

Each one is handcrafted so no two are exactly alike. \$15, plus s & h



heritage stickers

Dorothy's Memories, a new line of heritage stickers from Tumblebeasts (505-323-5554 • tumblebeasts.com), fill photographic gaps or embellish pages with visions of Grandma's kitchen, vintage clothing and antique toys. The line takes its name from Tumblebeasts' owner Karen Stockham's own grandmother, Dorothy. Karen wanted to create realistic images with a playful touch. \$1.85 per sheet

jot this down

A busy mom keeps journaling worthy tidbits on anything she can find, be it the calendar or the grocery list. Weeks later, that same busy mom goes nuts trying to collect all the bits and pieces for her scrapbook pages. If this sounds familiar, Jotters (877-JOTTER1 • jotters.net)

may be for you. The journals are compact and contain acid-free, perforated sheets so you can tear out your jottings to keep with your photos. \$9.99

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Portable Die Cutting the QuicKutz Way

Some things are simply destined to go together—apple pie and ice cream, Jack and Jill, scrapbooking and die cuts.

Die cuts have been around almost since the beginning of the scrapbooking craze, and the fact that they are still a major element of scrapbooking today attests to the value of this wonderful creative option. However, everyone knows that there is always room for improvement—or at least that's what the people at QuicKutz believe.

Utah-based QuicKutz produces and markets the latest and greatest in personal die cutting systems—a portable approach that delivers the sharp, crisp look of store die cuts in the comfort of your own home. The QuicKutz system includes the QuicKutz Hand Tool (or press), which weighs less than two pounds and is roughly ten inches long (see Figure 1), and QuicKutz Pocket Dies, which are two inches square, thinner than a credit card, and stored in convenient, compact custom-designed binders (see Figure 1). Although small, the system is superior—the dies are made of solid steel and will last a lifetime, and the hand tool is a carefully engineered, precision instrument.

QuicKutz offer an impressive variety of alphabets (see Figure 2)—nine different styles (more than any other personal die-cutting system) available in 1 1/4" letters; five of the styles are also available in a mini (5/8") size. All of the QuicKutz alphabets have matching numbers and punctuation, and six of the nine have matching shadows. In addition, QuicKutz has more than 175 different die cut shapes (see Figure 1) Currently, the company releases new shapes every month and a new alphabet every quarter.

The QuicKutz System was designed to be durable, portable, easy to use, and easy to store. Made entirely in the United States, QuicKutz is the only such system with a limited lifetime warranty. QuicKutz

dies make tens of thousands of cuts, all with the same sharp, clean quality as the first. And QuicKutz can be used for a wide variety of uses, including scrapbooking (see Figure 3), greeting cards, gift bags and boxes, picture frames, and more.

Using die cut letters, numbers, and shapes has never been easier, quicker, or more fun. But the best part about QuicKutz is not only do scrapbookers enjoy amazing variety, impressive versatility, and superior quality, they get it in a package so small that they can literally take it with them—anytime, anywhere.



Figure 3

**STAR
ROXY
GIDGET
HONEY
KHAKI
VENUS
ZELDA
Sonja
Marisa**

Figure 2

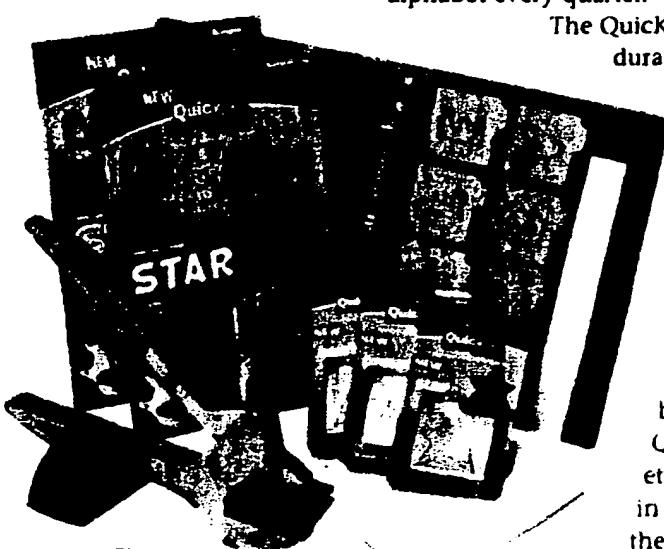
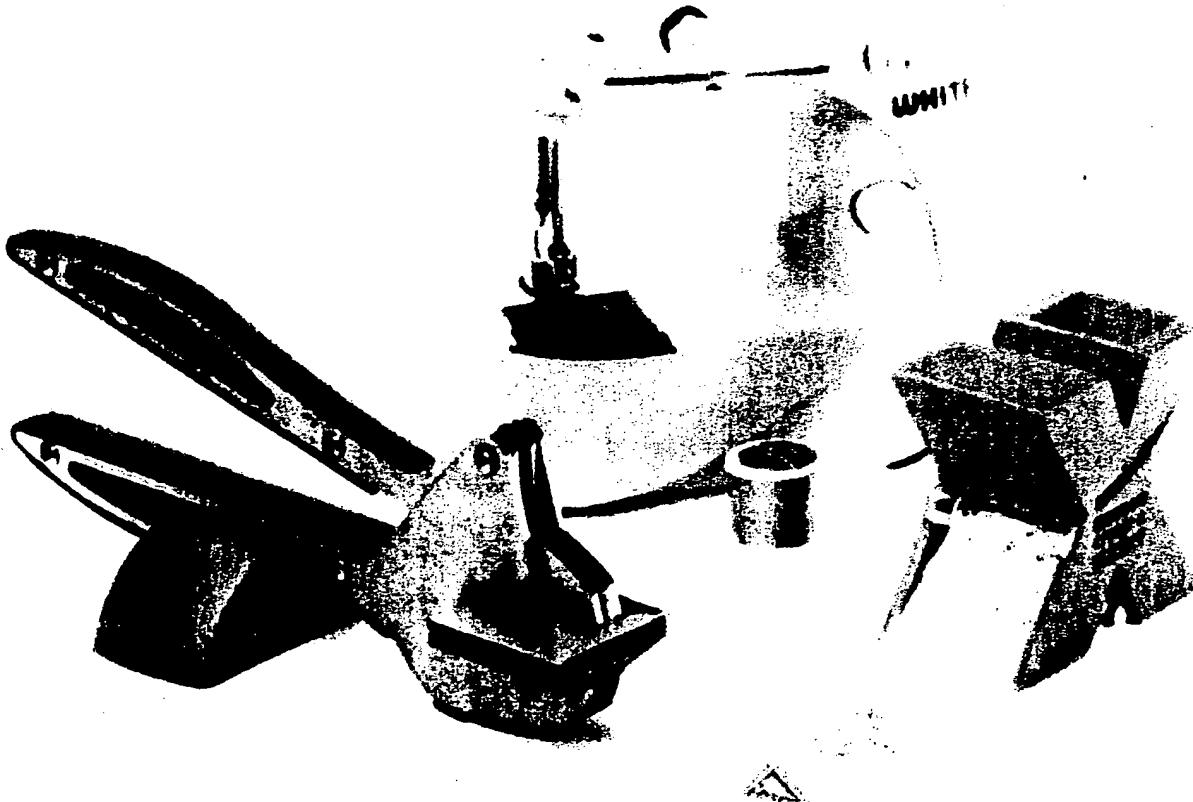


Figure 1



A B C scrapbooking top 50

mini mechanisms

"SCRAPBOOKING MEANS TAKING IT WITH YOU," says Amelia Parkin, public relations specialist and events coordinator for QuicKutz, Inc. "And if you're like me, it means wanting to take it all with you." That feeling is the driving force behind the trend to downsize—everything is getting smaller, from die-cutting machines to sewing machines. Manufacturers are saying, "You can take it with you." Last year, QuicKutz introduced a personal die-cutting system (shown above) weighing less than two pounds. Add 80 dies to reach three pounds. Compact equals portable equals practical, Amelia says.

"Several reasons exist for why smaller is appealing," says Major Maddon, Provo Craft's vice president of marketing. "It's cute, it represents ease and it's portable." Provo Craft also minimized by introducing the Sizzix personal die-cutting system.

Other companies following suit are Xyron and White Sewing. The Xyron 150 (shown above) makes stickers no wider than 1½", while the Sew Cute (shown above) sewing machine can handle most big sewing jobs at a fraction of the size and weight. It's battery operated, so it's totally portable.

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Exhibit B

Sizzix Information



Where Good Ideas Take Shape

Sizzix.com

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Ideas & Contests

Specials

News & Events

Shop Online

Customer Support

About Us

SEARCH Products

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Wednesday, July 28, 2004

Wish List Shopping Basket

Sizzix

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View Sizzix Movie
Sizzix Companies
Management Bios

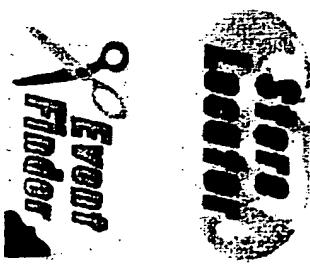
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Shaping the Future of Creativity


Crafting at home is now a whole lot easier and a lot more fun. The vision of Sizzix started as a personal die-cutting system and line of dies but has now evolved into a whole lot more. Giving crafters and scrapbookers an inexpensive and simple way to embellish and enhance any scrapbook page, greeting card or craft project is the perfect solution to the creative community. The design and functionality of Sizzix brand products allows crafters to create right in the convenience of their own home or take on the road to a school, scrapbooking event or friends house. Sizzix brand products are quickly becoming a complete crafting system of integrated and patented dies, embossing folders, punches, papers and storage systems all to help you create easier and faster than ever before.

The Sizzix brand and product line was co-developed by two

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companies that crafters look to first for innovative products and creative ideas. Ellison and Provo Craft knew that crafters wanted an affordable solution to creating die-cut designs and embellishments in their homes. Using Ellison's popular die-cutting machine design, the two companies developed a smaller, lighter, portable version. The Sizzix Machine's simple, straightforward design makes creating projects easy and fun for every crafter.

The original line of Sizzix dies includes hundreds of creative shapes for every event, holiday or occasion. In addition, Sizzix has a selection of alphabets, numbers and punctuation to add titles and words to your crafting projects. The original dies can cut a variety of materials such as paper, rubber, and fabric for every craft from scrapbooking, rubber-stamping or quilting. In fact, the Sizzix die-cutting system can cut up to three sheets of paper at once, resulting in perfect, clean cuts every time.

During the fall of 2003, the Sizzix brand introduced two new products, which work in the Sizzix Machine. Both new products require the use of a Sizzix System Converter. Sizzix product users can now get the added benefits of Sizzlits low profile dies and Simple Impressions Embossing Folders. Each unique in their design and patented in their functionality. The Simple Impressions Embossing Folders take the time and fuss out of embossing while leaving you with that beautiful, classy end result of embossed paper or metal in just seconds. The folders use a positive and negative of each design shape to sandwich your embossing material in between the folder while you press in your Sizzix Machine.

Sizzlits are a thin lightweight and portable die that is perfect for crafters on the go. Available in an easy to use storage case, you will love this die addition to the line. Extremely economical and easy to use these dies cut single sheets of card stock into detailed, decorative shapes for your next scrapbook, card or craft project.

Another innovative and clever idea from the Sizzix brand is the PaddlePunch. This new product works outside of the Sizzix Machine but addresses and overcomes the age-old issues with the

limitations of craft punches and their inability to punch in the middle of a page or only through thin paper. By using similar steel as in the original dies and a special hammer, crafters can add that decorative shape anywhere they want on hundreds of kinds of materials.

So if you are looking for inspiration, visit the Sizzix.com Web Site often – a virtual crafting community. It's chock full of ideas, projects and tips to satisfy the craftiest of crafters. Sign-up for The Sizzix.com Scoop monthly e-mail newsletter, and keep up-to-date with the latest and greatest in die-cutting and crafts.

Sizzix brand products can be purchased from thousands of craft stores around the United States and abroad as well as at www.sizzix.com and www.creativexpress.com. For more information, contact Sizzix.com toll free at 1-877-355-4766.

[Store Locator](#) | [Contact Us](#) | [Legal Notices](#) | [Privacy Policy](#)

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Exhibit C

AccuCut Information

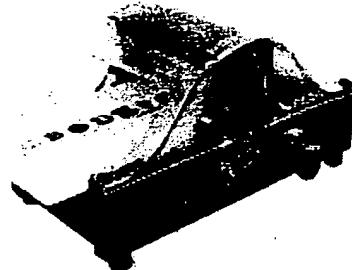
AccuCUT®

Making It Easy. Making It Fun.

AccuCut Re-Introduces DayCo Personal Die Cutter
Click [here](#) for a high resolution images for use with this article.

(Fremont, Neb.—July 16, 2004)—As a result of its recent acquisition of DayCo (a former competitor), AccuCut Systems re-introduced DayCo's Zip'eMate™ Personal Die Cutter as one of its own products. The machine will replace the AccuCut® Mini Machine, which is being phased out.

"The AccuCut® Zip'eMate™ machine has gone through rigorous quality testing to deliver a product synonymous with AccuCut," said product manager Cheyanne Atchley. "We are thrilled to introduce the double-roller personal die cutting machine as AccuCut's primary personal sized machine, and excited about offering this product to our customers as a fitting addition to the AccuCut line."



The Zip'eMate machine is the only personal die cutting machine that offers roller technology. It includes two gear-driven rollers that draw dies through the machine with minimal effort from the operator. As with all AccuCut machines, pressure is preset and applied by the machine itself rather than the operator. This provides a consistent cutting experience and eliminates the need to guess how hard to press, as with lever-operated machines.

In addition to cutting shapes, the Zip'eMate machine embosses any AccuCut shape, and will also emboss pre-purchased brass stencils. The machine is available in the four colors: purple, red, green and blue. With the use of a variety of cutting platforms and mats, the machine is compatible with all major dies on the market, including commercial dies, thin wood or plastic dies, and wafer-thin metal dies.

Consumers are encouraged to ask their local retailers about the AccuCut® Zip'eMate™ Personal Die Cutting Machine. Retailers may call 800-288-1670 to order, or order online at www.accucut.com.

AccuCut Systems was established in 1990 as a provider of shape and letter cutting products for retail craft stores, professional designers, craft enthusiasts and the educational market. The company's focus is on making craft and educational experiences fun and rewarding. AccuCut is a multi-winner of *Creating Keepsakes* magazine's Readers' Choice Award for best die cutting equipment, and the Primedia Award of Excellence. Visit AccuCut online at www.accucut.com.

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